

ESTTA Tracking number: **ESTTA585677**

Filing date: **02/05/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Southern Methodist University		
Entity	Corporation	Citizenship	Texas
Address	6425 Boaz Lane Dallas, TX 75205 UNITED STATES		

Attorney information	Daniel Chalker Chalker Flores, LLP 14951 N. Dallas Pkwy Suite 400 Dallas, TX 75254 UNITED STATES dchalker@chalkerflores.com, cminchillo@chalkerflores.com, docket@chalkerflores.com Phone: 214-866-0001
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### Applicant Information

Application No	85819705	Publication date	01/07/2014
Opposition Filing Date	02/05/2014	Opposition Period Ends	02/06/2014
Applicant	QuantaEd, LLC Suite 668 San Diego, CA 92130 CANADA		

### Goods/Services Affected by Opposition

Class 041. First Use: 2012/12/21 First Use In Commerce: 2012/12/21  
All goods and services in the class are opposed, namely: Non-downloadable electronic publications in the nature of educational curriculum for use by employees to enhance innovation competency

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	False Designation of Origin - Trademark Act section 43(a)

### Marks Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	INNOVATION GYMNASIUM		
Goods/Services	Educational services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	INNOVATION GYM		
Goods/Services	Educational services		

Attachments	Notice_of_Opposition_020514.pdf(99977 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Daniel Chalker/
Name	Daniel Chalker
Date	02/05/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Southern Methodist University	)	
	)	
Opposer,	)	Opposition No.: _____
	)	
v.	)	
	)	
QuantaEd, LLC	)	Mark: InnovationGym
	)	
Applicant.	)	Application Serial No.: 85/819,705
	)	

**NOTICE OF OPPOSITION**

Southern Methodist University, a Texas corporation, having an official address of 6425 Boaz Lane, Dallas, Texas 75205 (“SMU” or “Opposer”), believes that it will be damaged by registration of the InnovationGym mark in International Class 041 for “Non-downloadable electronic publications in the nature of educational curriculum for use by employees to enhance innovation competency”, filed in Application Serial No. 85/819,705 by QuantaEd, LLC, a California limited liability company, having a listed business address of 3525 Del Mar Heights Rd., Suite 668, San Diego, California 92130 (“QuantaEd” or “Applicant”), and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. Opposer is a nationally recognized university founded in 1911 and opened in 1915. In addition to research services, Opposer provides educational services and goods to students from all fifty states, the District of Columbia and approximately 90 foreign countries.

2. Since before the January 10, 2013 filing date of Applicant's Application Serial No. 85/819,705 ("Application") and the alleged December 21, 2012 dates of Applicant's first use, Opposer has marketed and provided educational services in interstate commerce in connection with its INNOVATION GYMNASIUM and INNOVATION GYM marks (collectively the "INNOVATION GYM Marks").

3. Opposer created the INNOVATION GYM Marks at least as early as 2007. By virtue of the excellence of Opposer's educational services provided in connection with the INNOVATION GYM Marks in interstate commerce, Opposer has developed significant goodwill in its INNOVATION GYM Marks and a valuable reputation.

4. Applicant applied for registration of the InnovationGym mark in International Class 41 (as amended), with the description of services as "Non-downloadable electronic publications in the nature of educational curriculum for use by employees to enhance innovation competency" (as amended) ("Applicant's Goods/Services").

5. Applicant's application to register and its proposed use of the InnovationGym mark in connection with Applicant's Goods/Services is without Opposer's consent or permission.

6. Upon information and belief, neither Applicant nor any predecessor or related company of Applicant made actual use of the InnovationGym mark prior to the claimed dates of first use of December 21, 2012.

7. Applicant's InnovationGym mark was published in the Trademark Official Gazette on January 7, 2014. An opposition to the Application must be filed by February 6, 2014. This Notice of Opposition is being filed on February 5, 2014. Therefore, this Notice of Opposition is being timely filed.

8. Opposer has common law rights in and to the INNOVATION GYM Marks through its continuous use of the INNOVATION GYM Marks long prior to the first actual or constructive use of the InnovationGym mark by Applicant.

### **COUNT I – LIKELIHOOD OF CONFUSION**

9. Opposer incorporates the allegations of Paragraphs 1 through 8.

10. The InnovationGym mark so resembles the INNOVATION GYM Marks as to be likely, when used on or in connection with Applicant's Goods/Services, to cause confusion, to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), as amended. The InnovationGym mark also conveys the same commercial impression as the INNOVATION GYM Marks.

11. Applicant's Goods/Services are similar to the education services and goods used in connection with Opposer's INNOVATION GYM Marks. Applicant's use and registration of the InnovationGym mark in connection with Applicant's Goods/Services is likely to cause confusion, deception and/or mistake among the relevant public.

12. The purchasing public is likely to be led to believe that goods/services bearing the InnovationGym mark emanate from or are approved, licensed, sponsored by, or in some other way are legitimately connected with or affiliated with, Opposer or that Applicant and its business are owned by or affiliated with Opposer and its business.

13. If Applicant is permitted to use the InnovationGym mark as specified in the Application, confusion in trade resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between the InnovationGym mark and the INNOVATION GYM Marks. Consumers familiar with the INNOVATION GYM Marks would be likely to believe Applicant's Goods/Services are provided by Opposer or provided with

Opposer's authorization or approval. Furthermore, any defect, objection or fault found with Applicant's Goods/Services sold under the InnovationGym mark would necessarily injure Opposer's reputation and the goodwill Opposer has established in the INNOVATION GYM Marks.

14. Applicant's use and registration of the InnovationGym mark will damage Opposer, its business and its goodwill.

## **COUNT II – FALSE DESIGNATION OF ORIGIN**

15. Opposer incorporates the allegations of Paragraphs 1 through 14.

16. The InnovationGym mark so resembles the INNOVATION GYM Marks as to be likely, when used on or in connection with Applicant's Goods/Services, to cause confusion, to cause mistake, or to deceive in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), as amended. The InnovationGym mark also conveys the same commercial impression as the INNOVATION GYM Marks.

17. Applicant's Goods/Services are similar to the education services and goods used in connection with Opposer's INNOVATION GYM Marks. Applicant's use and registration of the InnovationGym mark in connection with Applicant's Goods/Services is likely to cause confusion, deception and/or mistake among the relevant public as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship or approval of Applicant's Goods/Services or commercial activities.

18. The purchasing public is likely to be led to believe that goods/services bearing the InnovationGym mark emanate from or are approved, licensed, sponsored by, or in some other way are legitimately connected with or affiliated with, Opposer or that Applicant and its business are owned by or affiliated with Opposer and its business.

19. If Applicant is permitted to use the InnovationGym mark as specified in the Application, confusion in trade resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between the InnovationGym mark and the INNOVATION GYM Marks. Consumers familiar with the INNOVATION GYM Marks would be likely to believe Applicant's Goods/Services are provided by Opposer or provided with Opposer's authorization or approval. Furthermore, any defect, objection or fault found with Applicant's Goods/Services sold under the InnovationGym mark would necessarily injure Opposer's reputation and the goodwill Opposer has established in the INNOVATION GYM Marks.

20. Applicant's use and registration of the InnovationGym mark will damage Opposer, its business and its goodwill.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that Applicant's Application Serial No. 85/819,705 be denied registration and that such other and further relief as is deemed just and proper be granted.

Please address all correspondence to Daniel J. Chalker, at Chalker Flores, LLP, 14951 N. Dallas Parkway, Suite 400, Dallas, Texas 75254.

Dated: February 5, 2014

Respectfully submitted,

CHALKER FLORES, LLP

By: /s/ Daniel J. Chalker

Daniel J. Chalker

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**ATTORNEYS FOR OPPOSER**



### **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION was served on all parties, this the 5<sup>th</sup> day of February, 2014, by sending the same electronically through the Electronic System for Trademark Trials and Appeals (“ESTTA”) and first class mail, postage prepaid, to the following:

QuantaEd, LLC  
3525 Del Mar Heights Rd., Suite 668  
San Diego, California 92130

Jaredd Flynn  
THRASHER, DINSMORE & DOLAN  
100 7<sup>th</sup> Ave., Suite 150  
Chardon, OH 44024  
Phone Number: (440) 285-2242  
Fax Number: (440) 285-9423

/s/ Daniel J. Chalker

Daniel J. Chalker